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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of: **Michael WIEDEMAN et al.**

Group Art Unit: **3636**

Application Number: **10/035,334**

Examiner: **Anthony D. Barfield**

Filed: **January 4, 2002**

Confirmation Number: **2251**

For: **VEHICLE SEAT**

Attorney Docket Number: **011715**

Customer Number: **38834**

SUBMISSION OF APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

March 6, 2006

Sir:

Applicants submit herewith an Appeal Brief in the above-identified U.S. patent application.

Attached please find a check in the amount of \$500.00 to cover the cost for the Appeal Brief.

If any additional fees are due in connection with this submission, please charge our Deposit Account No. 50-2866.

Respectfully submitted,

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WFW/dlt



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

APPEAL BRIEF FOR THE APPELLANT

Ex parte Michael WIEDEMAN et al. (applicant)

VEHICLE SEAT

Application Number: **10/035,334**

Filed: **January 4, 2002**

Appeal No.:

Group Art Unit: **3636**

Examiner: **Anthony D. Barfield**

Submitted by:

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Date: March 6, 2006

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Appeal Brief
Application No. 10/035,334



Attorney Docket No. 011715

APPEAL BRIEF

(I) REAL PARTY IN INTEREST

The Applicants in this application are Michael Wiedeman, John A Frye, Frank D. Moburg, and Michael Tsay.

In an Assignment, executed by each of the Applicants on March 26, 2002, the Applicants have assigned the invention of this application to Honda Giken Kogyo Kabushiki Kaisha of Tokyo, Japan, who is the real party in interest

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(II) RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to appellant, appellant's legal representative, or assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(III) STATUS OF CLAIMS

Claims 1, 6-8, 10, 12, 25 and 28 are rejected under 35 U.S.C. §102(e) as being anticipated by Lohr (USP 6,568,735).

Claims 2-25, 9, 11, 13, 26, 27, 29 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

Claims 14-24 are allowed over the prior art of record.

(IV) STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final rejection dated September 15, 2005.

(V) SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter is directed to a seat (or seats) adapted for use in a vehicle having a floor and a roof. The claimed seat (or seats) are best illustrated in Figs. 1-4 in which a left and right vehicle seat 34, 36 are disposed in a vehicle 10. As described in paragraph [0015] on page 3 of the specification, vehicle seats 34, 36 are both supported by a central pillar 11. As best seen in Figs. 5 and 7, the central pillar 11 extends between and is supported by roof 26 and floor 28. For example, as also seen in Fig. 1, left vehicle seat 34 includes a left seat bottom 20, a left seat back 22, and a left headrest 24.

As best illustrated in Figs. 3 and 4 (see paragraphs [0017] and [0018] on page 6 of the specification), a central support 12 extends generally forwardly from central pillar 11 at a lower portion 11b thereof. Left and right lower ribs 14a and 14b extend laterally outwardly from center support 12 and support seat bottoms 20, 21. As also seen in Figs. 3, 5 and 7, left and right primary intermediate ribs 16a and 16b extend laterally outwardly from central pillar 11. Left and right secondary intermediate ribs 17a, 17b also extend laterally outwardly from central pillar 11, at a location below the left and right primary intermediate ribs 16a, 16b. Primary ribs 16a, 16b, either alone or in combination with secondary intermediate ribs 17a, 17b, support the left and right seat backs 22, 23, respectively.

Additionally, left and right upper ribs 18a and 18b extend outwardly and latterly from central pillar 11 and above primary intermediate ribs 16a, 16b (see paragraph [0019] on page 7 of

the specification). Headrests 24, 25 are supported by left and right upper ribs 18a, 18b, respectively.

Furthermore, as seen in Figs. 2, 3 and 5, grab handles 46a and 46b are provided on seat backs 22, 23, respectively (see paragraph [0020] on page 7 of the specification). As best illustrated in Fig. 3, grab handle 46a is supported by left primary intermediate rib 16a and left secondary intermediate rib 17a. Furthermore, as illustrated in Fig. 2, left and right openings 52, 54 are formed in seat backs 22, 23, respectively, at central top portions of each of the seat backs. Additionally, as illustrated in Fig. 6, openings 48, 50 are formed in a central front portion of seat bottoms 20, 21, respectively (see paragraph [0022] on page 7 of the specification).

(VI) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Grounds of rejection to be reviewed on appeal are whether claims 1, 6-8, 10, 12, 25 and 28 are unpatentable under 35 U.S.C. §102(e) as being anticipated by Lohr.

(VII) ARGUMENT

REJECTION UNDER 35 U.S.C. §102(E) AS BEING ANTICIPATED BY LOHR.

Claim 1

It is respectfully requested that the rejection of claims 1, 6-8, 10, 12, 25 and 18 under 35 U.S.C. §102(e) as being anticipated by Lohr, be withdrawn, since Lohr does not disclose each and every feature recited in the claims.

The Office Action dated September 15, 2005, finally rejects claims 1, 6-8, 10, 12, 25 and 28 under 35 U.S.C. §102(e) as being anticipated by Lohr. It is thus the position of the Office Action that Lohr discloses the following features recited in independent claim 1:

1. “a central pillar extending from the floor to the roof of the vehicle;
2. “a seat bottom directly fixed to and supported by said lower rib;
3. “a seat back fixed to and supported by said intermediate rib.”

It is respectfully submitted that the above elements of claim 1 are not disclosed by Lohr and thus cannot be anticipated by Lohr.

The issue presented for review is whether or not Lohr discloses the three elements described above with regard to claim 1. Lohr must disclose all of the elements of the claim, including those described above, in order to anticipate claim 1. If Lohr fails to disclose even one feature of claim 1 (including the three elements disclosed above), then claim 1 cannot be anticipated by Lohr.

1. Lohr does not disclose, “a central pillar extending from the floor to the roof of the vehicle;”

The above element of claim 1 requires that a “central pillar” extend from the floor to the roof of the vehicle. This central pillar is illustrated as reference numeral 11 in Fig. 1 of the instant application. The outstanding Office Action maintains that Lohr discloses such a “central pillar”. In response to Applicants’ arguments to the contrary in the response dated June 30, 2005, the Office Action states in its, “Response to Arguments”, that:

...the central pillar (11) as taught by Lohr could in fact be disposed in a central area of the vehicle and have another seating area disposed on the opposing side of the pillar, which is common and inherent in many mass transit vehicles. Applicant is reminded that there does not have to be a stated disclosure by Lohr of a central pillar but what would tone [sic] of ordinary skill in the art “gleam [sic] from the disclosure of Lohr who shows a pillar with a lateral rib, which is in accordance so far as defined by the claimed invention. (Emphasis supplied.)

The Office Action does not address the question of whether or not it is “common knowledge” to put such a central pillar in a vehicle of Lohr. The Office Action does not fulfil its duty under MPEP 2144.01(A) to provide evidentiary support for such an assertion.

Additionally, it is noted that simply suggesting that a reference “could” disclose or suggest a claimed feature is not sufficient. The Federal Circuit has stated that,

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” (Emphasis supplied.) In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

While the above case is addressing an obviousness rejection, the fact is that the standard for anticipation is even higher. Thus, if the obviousness standard is not met, as in the instant case,

then it certainly has not reached the anticipation standard. Lohr simply does not disclose this feature. The only way to arrive at this feature is to suggest that Lohr could have it, and “could” is not the proper standard.

Furthermore, as noted in column 3, lines 34-43, Lohr is intended to be used for an urban passenger transport vehicle, such as a tram, a metro, a bus, etc. The Office Action points to no language or drawings that indicate that vertical support 11 of Lohr is a “central pillar”. In fact, if it is to be used on a bus or metro, etc., it is expected that support 11 would not be used as a “central pillar”, since such buses and metro vehicles normally have an open center aisle, and a “central pillar” would be an obstruction for people using such a vehicle.

Specifically, the Office Action states that a vertical support 11 as shown in Lohr, “could in fact be disposed in a central area of the vehicle...” Further the Office Action indicates that doing so, “is common and inherent in many mass transit vehicles.” However, “could” is not the standard under 35 U.S.C. § 102(e), as discussed above.

Appellant respectfully traverses this assertion in the Office Action. It is not clear whether the Office Action is taking Official Notice of such factor by simply indicating that it is “common knowledge.” As noted in MPEP 2144.03, Official Notice should only be taken when “the facts asserted to be well-known or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” Appellant submits that such is not the case with the claimed “central pillar.” As stated above, Appellant submits that such a central pillar is not used in mass transit cars because the need for easy access for riders would argue against putting such a “central pillar” in the middle of a bus or metro train. Additionally, MPEP

2144.03(A) states that it is “not appropriate to rely on “common knowledge” without evidentiary support in the record...” There is no such evidentiary support in this record. Furthermore, MPEP 2144.04(C) states:

If applicant adequately traverses the examiner’s assertion of Official Notice, the examiner must provide documentary evidence in the next Office Action if the rejection is to be maintained.

The response dated June 30, 2005 specifically traversed the assertion of the Office Action that it is common for mass transit vehicles to have a central pillar on which seats are mounted. Applicants submit that “one of ordinary skill in the art” would not believe that vertical support 11 of Lohr would be a “central pillar”. However, in the Office Action dated September 15, 2005, no such evidentiary support was provided for the record.

As noted in Lohr, the specification states the following, under the title, “Field of the Invention”:

The present invention concerns a seat, a banquette, or other seating for a passenger transport vehicle designed to be cantilevered to a vertical support on the vehicle. The seat is attached by one of its lateral walls in order to free the space between the lower portion of the seat and the vehicle floor.

Furthermore, Figs. 1-6, 9 and 10 all illustrate a view of a suspended seat mounted on the same vertical support 11. It is clear from these views that vertical support 11 is, in fact, on the outside of the vehicle and not a “central pillar” as suggested in the Office Action. Attached to this Appeal Brief, are Exhibits 1-6 which are copies of Figs. 3-6, 9 and 10, respectively. In Exhibit 1, for example, a copy of Lohr’s Fig. 3 is provided. Exhibit 1 has been annotated to emphasize the shading lines which represent the glass of windows of the vehicle. As can be seen from Exhibit

1 (Fig. 3) the windows are clearly along the outside wall of the vehicle, as is vertical support 11. The same shading lines are annotated in Exhibits 2-6. Since it is the same vertical support in all of the figures (Figs. 1-10), it can also be deduced that vertical support 11 is part of the outside wall in all figures of Lohr, and is not a “central pillar”.

2 Lohr does not disclose a “seat bottom directly fixed and supported by said lower rib;”

The Office Action suggests that the “lower rib” of claim 1 is shown by the lower cross piece 5 in Fig. 1 of Lohr. Claim 1 requires “a seat bottom directly fixed to and supported by said lower rib”. The lower portion 9 of the seat of Fig. 1 of Lohr is not “directly fixed to” a lower rib. In fact it is directly fixed to horizontal branches 7 of side pieces 3 and 4. Accordingly, the structure of Lohr is simply different from what is claimed. The lower portion 9 of the seat of Lohr is not directly fixed to cross piece 5, but to side pieces 3 or 4, which are not “ribs” extending laterally. Thus, lower cross piece 5 does not disclose the structure of the “seat bottom” of claim 1, which is “directly fixed to” the lower rib.

Thus, Lohr does not disclose this feature recited in claim 1. Moreover, the outstanding Office Action does not respond to Applicants’ remarks regarding this element of claim 1 in the June 30, 2005 response. Accordingly, it is submitted that there can be no anticipation of claim 1 by Lohr, because Lohr does not disclose, “a seat bottom directly fixed to and supported by said lower rib”.

3. Lohr does not disclose, “a seat back fixed to and supported by said intermediate rib.”

Furthermore, claim 1 also requires that the seat back be “fixed to and supported by said intermediate rib”. The Office Action takes the position that the upper cross piece 5 is the intermediate rib. As with the seat bottom, the upper portion 8 of the seat of Lohr is not attached to upper cross piece 5, but is attached to the vertical branches 6, 6 of side pieces 3 and 4. Vertical branches 6, 6 of side pieces 3 and 4 are not “ribs” and do not extend “laterally” from the central pillar. In fact, Lohr refers to them as “vertical branches 6, 6” and not as lateral portions. Accordingly, the seat back is not “fixed to” the upper cross piece 5 of Lohr.

Thus, claim 1 requires that the seat back be fixed to and supported by the intermediate rib. Lohr simply does not disclose this feature either.

Also, the Office Action did not respond to this argument set forth in Applicants’ June 30, 2005 response. It is submitted that this element of claim 1 is clearly not disclosed by Lohr, and therefore claim 1 cannot be anticipated by Lohr.

Claim 2

Claim 2 recites a “grab handle on an outer edge thereof, nearest a door of the vehicle.” While gripping or restraint device 25 is illustrated in Fig. 7 of Lohr, this device 25 is formed on the inside, not on an “outer edge thereof nearest a door of the vehicle.”

Accordingly, in addition to the fact that claim 6 is dependent from independent claim 1, the features of claim 6 are not disclosed by Lohr.

Claim 7

Claim 7 also is dependent from claim 1, and claims a “grab handle disposed on an outer edge thereof, nearest a door of the vehicle”, similar to claim 6. Furthermore, claim 7 also requires that the grab handle have “opposing ends, each end supported by one of said intermediate ribs”. The restraint device of Fig. 7 does not show any such structure. In other words, restraint device 25 of Lohr is not on an “outer edge thereof, nearest a door of the vehicle”, and further, there is no disclosure that the device 25 has, “each end supported by one of said intermediate ribs.”

Thus, in addition to being dependent from independent claim 1, claim 7 also has additional features which are not disclosed by Lohr.

Claim 8

Claim 8 recites that the seat is a “front seat of the vehicle”. On the contrary, there is no disclosure whatsoever in Lohr that the disclosed seat for a passenger transport vehicle is a “front seat”.

Accordingly, in addition to the fact that claim 8 is dependent from independent claim 1, there is no disclosure in Lohr of the limitation of claim 8.

Claim 10

Claim 10 requires that the seat bottom, “has an opening at a central front portion thereof.” Fig. 6 provides an illustration of this limitation in which reference numerals 48 and 50 represent

openings. Lohr does not disclose this type of seat bottom. Accordingly, claim 10 also cannot be anticipated by Lohr.

In addition to the fact that claim 10 is dependent from independent claim 1, the above-described feature is not disclosed in Lohr.

Claim 12

Claim 12 requires that the seat back have, “an opening at a central top portion thereof”. This is illustrated by reference numerals 52, 54 and Fig. 2. Accordingly, as noted above with claim 10, Lohr does not disclose such openings in its disclosure of transport vehicle seats.

In addition to being dependent from independent claim 1, claim 12 is not anticipated by Lohr since Lohr does not disclose the limitations described above.

Claim 25

The arguments set forth above with regard to claim 1 also apply to claim 25.

Claim 28

The arguments set forth above with regard to claim 1 also apply to claim 28.

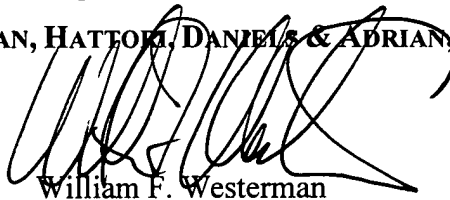
(VIII) CONCLUSION

In view of the remarks above, Appellant respectfully submits that the rejection of claims 1, 6-8, 10, 12, 25 and 25 should be withdrawn.

If this paper is not timely filed, Appellant hereby petitions for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 50-2866, along with any other additional fees that may be required with respect to this paper.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

A large, stylized handwritten signature in black ink, appearing to read 'W. F. Westerman', is written over the printed name and firm name.

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WFW/dlt

CLAIM APPENDIX

1. A seat adapted for use in a vehicle having a floor and a roof, comprising:
 - a central pillar extending from the floor to the roof of the vehicle;
 - a center support extending forwardly from said central pillar;
 - a lower rib extend laterally from said center support;
 - a seat bottom directly fixed to and supported by said lower rib;
 - a primary intermediate rib extending laterally from said central pillar; and
 - a seat back fixed to and supported by said intermediate rib.
2. The seat for a vehicle of claim 1, further comprising:
 - an upper rib extending laterally from said central pillar above said intermediate rib; and
 - a headrest fixed to and supported by said upper rib.
3. The seat for a vehicle of claim 2 further comprising:
 - a secondary intermediate rib extending laterally from said central pillar and also fixed to and supporting said seat back.
4. The seat for a vehicle of claim 1, wherein said central pillar includes a support member extending forwardly from an upper portion thereof and fixed to the roof of the vehicle.

5. The seat for a vehicle of claim 1, wherein said primary intermediate and upper ribs are adjustable along said central pillar.

6. The seat for a vehicle of claim 1, wherein said seat back includes a grab handle on an outer edge thereof, nearest a door of the vehicle.

7. The seat for a vehicle of claim 1, further comprising:
a secondary intermediate rib extending laterally from said pillar and also fixed to and supporting said seat back, said seat back including a grab handle disposed on an outer edge thereof, nearest a door of the vehicle, wherein said grab handle has opposing ends, each end supported by one of said intermediate ribs.

8. The seat for a vehicle of claim 1, wherein said seat is a front seat of the vehicle.

9. The seat for a vehicle of claim 1, further comprising a hand brake lever supported by and extending from a forward end of said center support.

10. The seat for a vehicle of claim 1, wherein said seat bottom has an opening at a central front portion thereof.

11. The seat for a vehicle of claim 10, wherein said opening is covered with a mesh like fabric.

12. The seat for a vehicle of claim 1, wherein said seat back has an opening at a central top portion thereof.

13. The seat for a vehicle of claim 12, wherein said opening is covered with a mesh like fabric.

14. A pair of seats for a vehicle having a floor and a roof, comprising:
a central pillar extending from the floor to the roof of the vehicle;
a center support extending forwardly from said central pillar;
left and right lower ribs extending outwardly from said center support;
a pair of seat bottoms, each seat bottom directly fixed to and supported by one of said lower ribs;

left and right primary intermediate ribs extending outwardly from said center pillar; and
left and right seat backs fixed to and supported by said respective left and right intermediate ribs.

15. The pair of seats for a vehicle of claim 14, further comprising:
left and right upper ribs extending outwardly from said central pillar; and
left and right headrests fixed to and supported by said respective left and right upper ribs.
16. The pair of seats for a vehicle of claim 14, further comprising:
secondary left and right intermediate ribs extending outwardly from said central pillar and
spaced apart downwardly therefrom, each of said secondary left and right intermediate ribs also
fixed to and supporting said respective left and right seat backs.
17. The pair of seats for a vehicle of claim 16, further comprising:
left and right upper ribs extending outwardly from said central pillar; and
left and right headrests fixed to and supported by said respective left and right upper ribs.
18. The pair of seats for a vehicle of claim 16, further comprising left and right grab
handles, each formed on an outer edge of said respective left and right seat backs.
19. The pair of seats for a vehicle of claim 18, wherein each of said left and right grab
handles has opposing ends, each end supported by one of said respective left or right intermediate
ribs.

20. The pair of seats for a vehicle of claim 14, wherein said pair of seats are front seats of the vehicle.

21. A pair of seats for a motor vehicle having a roof and a floor, comprising:
a central pillar extending from the floor to the roof of the motor vehicle;
a center support extending forwardly substantially along a center line of the motor vehicle;
left and right lower ribs extending outwardly from said center support on opposite sides thereof;
left and right seats fixed to and supported by said respective left and right lower ribs;
left and right primary intermediate ribs extending outwardly from said central pillar, on opposite sides thereof;
left and right secondary intermediate ribs extending outwardly from said central pillar, on opposite sides thereof, and spaced from said respective left and right primary intermediate ribs, downwardly along said central pillar;
left and right upper ribs extending outwardly from said central pillar, on opposite sides thereof; and
left and right headrests fixed to and supported by said respective left and right upper ribs.

22. The pair of front seats for a motor vehicle of claim 21, further comprising:
left and right grab handles, each disposed on an outer edge of said respective left and right seat backs.

23. The pair of front seats for a motor vehicle of claim 22, wherein said left and right grab handles each has opposing ends, wherein each end of each grab handle is supported by a corresponding one of said primary and secondary intermediate ribs.

24. The pair of front seats for a motor vehicle of claim 21, further comprising a hand brake lever supported by and extending from a forward end of said center support.

25. A seat adapted for use in a vehicle having a floor and a roof, comprising:
a central pillar extending from the floor to the roof of the vehicle;
a lower rib extend laterally from said central pillar;
a seat bottom fixed to and supported by said lower rib;
a primary intermediate rib extending laterally from said central pillar; and
a seat back fixed to and supported by said intermediate rib.

26. The seat for a vehicle of claim 25, further comprising:

an upper rib extending laterally from said central pillar above said intermediate rib; and
a headrest fixed to and supported by said upper rib.

27. The seat for a vehicle of claim 25 further comprising;

a secondary intermediate rib extending laterally from said central pillar and also fixed to
and supporting said seat back.

28. A seat adapted for use in a vehicle having a floor and a roof, comprising:

a pillar extending from the floor to the roof of the vehicle;
a center support extending forwardly from said pillar;
a lower rib extend laterally from said center support;
a seat bottom fixed to and supported by said lower rib;
a primary intermediate rib extending laterally from said pillar; and
a seat back fixed to and supported by said intermediate rib.

29. The seat for a vehicle of claim 28, further comprising:

an upper rib extending laterally from said pillar above said intermediate rib; and
a headrest fixed to and supported by said upper rib.

30. The seat for a vehicle of claim 29, further comprising:
a secondary intermediate rib extending laterally from said pillar and also fixed to and supporting said seat back.

EVIDENCE APPENDIX

Exhibit 1	Annotated Fig. 3
Exhibit 2	Annotated Fig. 4
Exhibit 3	Annotated Fig. 5
Exhibit 4	Annotated Fig. 6
Exhibit 5	Annotated Fig. 9
Exhibit 6	Annotated Fig. 10
Exhibit 7	<u>In re Gordon</u> , 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)

733 F.2d 900, *, 1984 U.S. App. LEXIS 15015, **;
221 U.S.P.Q. (BNA) 1125
LEXSEE

IN RE LUCAS S. GORDON and KARL M. SUTHERLAND

Appeal No. 83-1281

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

733 F.2d 900; 1984 U.S. App. LEXIS 15015; 221 U.S.P.Q. (BNA) 1125

May 10, 1984

PRIOR HISTORY: [1]**

Appealed from: United States Patent and Trademark Office Board of Appeals. Serial No. 124,312.

DISPOSITION:

REVERSED.

COUNSEL:

James W. Geriak, of Los Angeles, California, argued, for Appellants. With him on the brief was Bradford J. Duft.

John F. Pitrelli, of Arlington, Virginia, argued, for Appellee. With him on the brief were Joseph F. Nakamura, Solicitor and John W. Dewhirst, Associate Solicitor.

JUDGES:

Bennett, Circuit Judge, Skelton, Senior Circuit Judge, and Miller, Circuit Judge.

OPINIONBY:

MILLER

OPINION:

[*900] MILLER, Circuit Judge.

This appeal is from the decision of the United States Patent and Trademark Office ("PTO") Board of Appeals ("board") affirming the examiner's rejection of appellants' claims n1 1-3 and 5-7 as unpatentable under 35 U.S.C. § 103. We reverse.

n1 In application Serial No. 124,312, filed February 25, 1980, for a "Blood Filter."

THE INVENTION

Appellants claim a "blood filter assembly" used during surgery and other medical procedures involving the handling of blood to remove clots, bone debris, [**2] tissue, or other foreign materials from blood before it is returned to a patient's body. Unlike blood filter assemblies widely used in the prior art, the device of the present invention permits both entry of the blood into, and ultimate discharge of the blood out of, the *bottom* end of the filter assembly, as shown below. n2

n2 Extraneous numbers have been removed from this and the subsequent drawing for clarification.

[*901] [SEE FIG. 1 IN ORIGINAL]

The blood filter assembly comprises a shell 1 provided with blood inlet 3 and blood outlet 4. Between the blood inlet and the blood outlet is filter medium 6 positioned within the filter medium core 7.

The location of blood inlet 3 is such that the incoming blood is directed along a spirally upward path by the inner wall of the shell. Further, the location of the blood inlet at the bottom end of the filter assembly facilitates the removal of gas bubbles by allowing them to rise upwardly out of the blood. The gas bubbles so removed are released [**3] from the blood filter assembly by means of a gas vent 5 located in the region of the top end of the assembly.

Independent claim 1, from which the other appealed claims depend, is illustrative:

Blood filter assembly comprising:

a. a shell having a first top end and a second bottom end,

b. a blood inlet located in the region of said bottom end and opening into said bottom end,

733 F.2d 900, *; 1984 U.S. App. LEXIS 15015, **;
221 U.S.P.Q. (BNA) 1125

c. a blood outlet located in the region of said bottom end,

d. a gas vent located in the region of said top end, and

e. a blood filter medium located between said blood inlet and said blood outlet,

said blood inlet being located and configured in a manner capable of directing incoming blood in a generally spiral path within said shell.

Claims 2, 3, and 5-7 further define the shape of the shell, the shape of the filter medium, and the nature of the material used as the filter medium.

PRIOR ART

The sole reference relied upon by the board is United States Patent No. 1,175,948, issued March 21, 1916, to French. French discloses a liquid strainer for removing dirt and water from gasoline and other light oils. As shown below, the inlet 4 and outlet 5 of the French device are both [**4] at the top end of the device.

[SEE ILLUSTRATION IN ORIGINAL]

[*902] A continuous helical tooth or thread 8 is formed integral with the inner wall of shell 1 and imparts to the incoming liquid a whirling motion, which gives the liquid a scouring action to help clean the surface of a metal screen filter 21 and guides unwanted dirt and water downwardly into a pocket 9 in the bottom of the shell. A pair of shelves 10 and 11, projecting inwardly and downwardly from the inner wall of the shell, further assists the entrance of dirt and water into the pocket 9 and prevents their being drawn back into the main chamber 12. The reference expressly states, "gravity assists in the separation of heavier oils or water." A pet-cock 13, projecting vertically downward from the bottom of the pocket is used to remove the collected dirt and water periodically. The top of the liquid strainer is completely closed by gland 3 except for the inlet and outlet openings.

BOARD OPINION

The board held that the appealed claims were drawn to an apparatus which "would have at least been rendered *prima facie* obvious to one of ordinary skill in the art by the apparatus disclosed in French." [**5] The board's reasoning was that it would have been obvious to turn the French device upside down to have both the inlet and outlet at the bottom, rather than at the top; and to employ

French's "pet-cock" as the claimed "gas vent." In the board's opinion, no patentable distinction was created by viewing French's apparatus from one direction and the claimed apparatus from another.

ANALYSIS

We are persuaded that the board erred in its conclusion of *prima facie* obviousness. The question is not whether a patentable distinction is created by viewing a prior art apparatus from one direction and a claimed apparatus from another, but, rather, whether it would have been obvious from a fair reading of the prior art reference as a whole to turn the prior art apparatus upside down. French teaches a liquid strainer which relies, at least in part, upon the assistance of gravity to separate undesired dirt and water from gasoline and other light oils. Therefore, it is not seen that French would have provided any motivation to one of ordinary skill in the art to employ the French apparatus in an upside down orientation. The mere fact that the prior art could be so modified would not have made [**6] the modification obvious unless the prior art suggested the desirability of the modification. See *Carl Schenck, A. G. v. Nortron Corp.*, 713 F.2d 782, 787, 218 U.S.P.Q. (BNA) 698, 702 (Fed. Cir. 1983), and *In re Sernaker*, 702 F.2d 989, 995-96, 217 U.S.P.Q. (BNA) 1, 6-7 (Fed. Cir. 1983), both citing *In re Imperato*, 486 F.2d 585, 587, 179 U.S.P.Q. (BNA) 730, 732 (CCPA 1973).

Indeed, if the French apparatus were turned upside down, it would be rendered inoperable for its intended purpose. The gasoline to be filtered would be trapped in pocket 9, and the water French seeks to separate would flow freely out of the outlet 5. Further, unwanted dirt would build up in the space between the wall of shell 1 and screen 21, so that, in time, screen 21 would become clogged unless a drain valve, such as pet-cock 13, were re-introduced at the new "bottom" of the apparatus. See *In re Schulpen*, 55 C.C.P.A. 960, 390 F.2d 1009, 1013, 157 U.S.P.Q. (BNA) 52, 55 (CCPA 1968). In effect, French teaches away from the board's proposed modification.

Because the PTO has failed to establish a *prima facie* case of obviousness, the rejection of claims 1-3 and 5-7 as unpatentable under 35 [**7] U.S.C. § 103 must be reversed. n3

n3 Because our holding that the PTO has failed to establish a *prima facie* case is dispositive, it is unnecessary to reach other arguments raised by appellants.

REVERSED.

Appeal Brief
Application No. 10/035,334

Attorney Docket No. 011715

RELATED PROCEEDINGS APPENDIX

None.